

Request for Reconsideration:

Although on the Form PTOL-326, the Examiner indicates that the outstanding Office Action is “non-final,” the Examiner asserts in the Conclusion (Office Action, Page 5, Para. 5) that “THIS ACTION IS MADE FINAL.” Applicant believes that the assertion of finality in the Conclusion is in error. This Office Action is the first consideration on the merits of amendments submitted with a Request for Continued Examination (RCE). In addition, the Examiner asserts that the grounds for rejection raised in the last Office Action prior to the filing of the RCE “are moot in view of the new grounds of rejection” presented in this Office Action. Office Action, Page 4, Para 4. Therefore, Applicant maintains that it is premature for the Examiner to make the rejections raised in this Office Action final. MPEP 706.07.

Because Applicant believes that the Examiner’s indication of finality in the Conclusion to this Office Action is in error, Applicant believes that no separate petition to withdraw the finality of the rejections now is due. Nevertheless, if the Examiner believes that these claims may be finally rejected by this Office Action, Applicant respectfully requests that the Examiner withdraw the finality of the present rejections in view of the inconsistencies in the indication of the status of the rejections between the Form PTOL-326 and the Conclusion of the Office Action. Applicant respectfully requests that the Examiner reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Rejections

Applicant acknowledges with appreciation that the Examiner has withdrawn the rejections of claims 1-19 under 35 U.S.C. § 103(a), as allegedly rendered obvious by U.S. Patent No. 6,138,119 to Hall et al. ("Hall") in view of Published Patent Application No. US 2002/0023109 A1 to Lederer, Jr. et al. ("Lederer II"). Nevertheless, claims 1-19 now stand under 35 U.S.C. § 103(a), as allegedly rendered obvious by Hall in view of Lederer II, and further in view of Patent Application Publication No. US 2005/0149452 A1 to Clayton et al. ("Clayton"). Applicant respectfully disagrees.

2. Obviousness Rejections.

As noted above, claims 1-19 stand rejected as allegedly rendered obvious by Hall in view of Lederer, and further in view of Clayton. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, the prior art reference or references must disclose or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the reference itself or the combined references or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the cited references, in the manner proposed by the Office Action. Third, there must be a reasonable expectation of success. MPEP 2143. For the reasons set forth below, Applicant respectfully disagrees.

Applicant previously has remarked that Hall in view of Lederer II fail to disclose limitations of the claimed invention and that there is no suggestion, motivation, or incentive to combine Hall and Lederer II in the manner proposed by this and earlier Office Actions. Those previous remarks remain relevant to the current rejections and are incorporated herein by reference. By these new grounds for rejection, however, the Office Action acknowledges that the combination of Hall with Lederer II fails to establish a prima facie case of obvious with respect to amended claims 1-19. Thus, the Office Action now relies on the alleged teachings of Clayton to supply the limitations of the claimed invention that are missing from Hall in combination with Lederer II.

a. Clayton's Effective Filing Date.

In order for Clayton to be applied against Applicant's claimed invention, Clayton must be prior art with respect to Applicant's claimed invention, i.e., Clayton must have an

critical reference date earlier than the filing date of the above-captioned patent application. According to MPEP 2136.03.III,

The **35 U.S.C. 102(e)** critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions >if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph<. See MPEP § 706.02(f)(1), examples 5 to 9.

(Emphasis added bol.) Applicant contends that the Office Action fails to demonstrate that the portions of Clayton relied on in support of the obviousness rejections are entitled to a sufficiently early, critical reference date, such that Clayton may be applied against Applicant's claims.

Clayton's earliest claim to priority is to a provisional patent application, U.S. Provisional Patent Application No. 60/174,662 ("Clayton-Prov.," copy enclosed), filed January 6, 2000. Clayton-Prov. was converted to a utility patent application, U.S. Patent Application No. 09/754,898 ("Clayton-Conv."), filed on January 5, 2001. Thus, Clayton-Prov. was filed about six months prior to the filing date of Applicant's application, i.e., July 27, 2000; and Clayton-Conv. was filed about six months after to the filing date of Applicant's application. Because Clayton was published on July 7, 2005, Clayton is entitled to a effective filing date of January 6, 2000, i.e., the filing date of Clayton-Prov. Nevertheless, Clayton's entitlement to a Section 102(e) critical reference date only extends to subject matter for which there is an enabling disclosure in Clayton-Prov.

With respect to Clayton, the Office Action contends that Clayton "teaches 'wherein said at least one requirement for complying with at least one standards, regulations and laws does not control or manage access to said compliance data.'" Office Action Page 3, Lines 7-9. In support of this contention, the Office Action cites to Clayton, Para. [0012] and Abstract. Nevertheless, neither Clayton's Para. [0012] nor Clayton's Abstract appears in Clayton-Prov. In fact, Clayton-Prov. only includes four (4) pages of text¹ and four (4) sheets of drawings (including drawings corresponding to **Figs 3-5** of Clayton). Clearly, the disclosure of Clayton is significantly more extensive than the disclosure of Clayton-Prov. To the extent that the Office Action relies on portions of the Clayton that do not appear in Clayton-Prov., the Office Action

¹ Applicant does not include the title page or the table of contents page in this total.

must, but fails to, demonstrate that Clayton-Prov. provides not only a disclosure, but an enabling disclosure, of the subject matter of the later added text of Clayton, on which the Office Action relies to support the obviousness rejections. Because the cited text does not appear in Clayton-Prov. and because the Office Action fails to demonstrate that Clayton-Prov. provides an enabling disclosure of the subject matter of the cited text, as required, the Office Action has failed to demonstrate that Clayton is entitled to a Section 102(e) critical reference date with respect to the cited Clayton text. Therefore, Applicant maintains that the Office Action fails to establish a prima facie case of obviousness with respect to the claimed invention and respectfully requests that the Examiner withdraw the obviousness rejections of claims 1-19 as allegedly rendered obvious by Hall in view of Lederer II, and further in view of Clayton.

b. Deficiency in Clayton's Disclosure.

Assuming *arguendo* that the subject matter of Clayton's Para. [0012] and Abstract were enabled properly by Clayton-Prov., Applicant maintains that the cited text does not supply those limitations of claims 1-19 that the Office Action acknowledges to be missing from Hall in view of Lederer II. In particular, the Office Action contends that:

[i]t would have been obvious at the time of the invention for one [of] ordinary skill in the art to have combined the teachings of Clayton with Hall and Lederer above using the steps of "wherein said at least one requirement for complying with at least one standards, regulations and laws does not control or manage access to said compliance data" would have given those skilled in the art the ability to apply requirement data in conjunction with complying elements in regard to accessing data. This give[s] users [the] advantage of managing access of sensitive data more efficiently.

(Emphasis added.) Initially, Applicant notes that according to the claimed invention said "at least one requirement . . . does not control or manage access to said compliance data." Thus, the proposed combination which would allow "those skilled in the art the ability to apply requirement data in conjunction with complying elements in regard to accessing data" appears contrary to the claimed invention. Further, Applicant states that "[c]ompliance data informs, instructs, or guides users to act in accordance with a compliance authority's rules or expectations, e.g., a product manufacturer, such as a drug or medical device manufacturer, establishes procedures for shippers or couriers to eliminate or reduce mix-ups, damage, deterioration, contamination, or other adverse effects to a product during handling." Appl'n, Page 1, Lines 23-27 (emphasis added). In Clayton, the "user" does not comply with the privacy

rules, the Privacy Council must comply. Clayton's user appears merely to agree or to refuse to use the Privacy Council's web application. See Clayton, Para. [0012] (Item (1) regarding informing the user of the entity's "certified" compliance with privacy and data security practices and Item (2) regarding obtaining the user's consent for the entity to receive and use the user's data in accordance privacy laws and regulations).

Thus, even if the subject matter of Clayton's Para. [0012] and Abstract is enabled by Clayton-Prov., Clayton does not teach the limitations of the claimed invention that the Office Action acknowledges are missing from Hall in view of Lederer II. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejections of claims 1-19 as allegedly rendered obvious by Hall in view of Lederer II, and further in view of Clayton.

Conclusion:

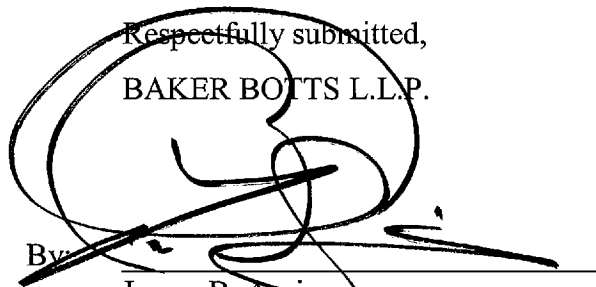
Applicant respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representatives, either in person or by telephone, would expedite prosecution of this application, we would welcome such an opportunity.

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Enclosures

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